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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,774	12/21/2000	Christine A. Klein	CPI-012CP5DV	5116

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LAHIVE & COCKFIELD
28 STATE STREET
BOSTON, MA 02109

EXAMINER

LI, RUIXIANG

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 09/24/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/747,774

Applicant(s)

KLEIN ET AL.

Examiner

Ruixiang Li

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-53 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 2 (both in part), 3, 5 (in part), and 6, drawn to a mixture of recombinant cells expressing a nuclear receptor, classified in class 435, subclasses 325, 252.3, 254.11, and 254.2.
- II. Claims 1, 2, 4, 5, 7-19, 23-29, 35-42, and 49-53 (all in part), drawn to a mixture of recombinant cells expressing a cell surface receptor, a chemoattractant peptide receptor, classified in class 435, subclasses 325, 252.3, 254.11, and 254.2.
- III. Claims 1, 2, 4, 5, 7-19, 23-29, 35-42, and 49-53 (all in part), drawn to a mixture of recombinant cells expressing a cell surface receptor, a neuropeptide receptor, classified in class 435, subclasses 325, 252.3, 254.11, and 254.2.
- IV. Claims 1, 2, 4, 5, 7-19, 23-29, 35-42, and 49-53 (all in part), drawn to a mixture of recombinant cells expressing a cell surface receptor, a light receptor, classified in class 435, subclasses 325, 252.3, 254.11, and 254.2.
- V. Claims 1, 2, 4, 5, 7-19, 23-29, 35-42, and 49-53 (all in part), drawn to a mixture of recombinant cells expressing a cell surface receptor, a neurotransmitter receptor, classified in class 435, subclasses 325, 252.3, 254.11, and 254.2.
- VI. Claims 1, 2, 4, 5, 7-19, 23-29, 35-42, and 49-53 (all in part), drawn to a mixture of recombinant cells expressing a cell surface receptor, a cyclic AMP receptor, classified in class 435, subclasses 325, 252.3, 254.11, and 254.2.

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- VII. Claims 1, 2, 4, 5, 7-19, 23-29, 35-42, and 49-53 (all in part), drawn to a mixture of recombinant cells expressing a cell surface receptor, a polypeptide hormone receptor, classified in class 435, subclasses 325, 252.3, 254.11, and 254.2.
- VIII. Claims 1, 2, 4, 5, 7-17 (all in part), 20, 21, 23-27 (in part), 30, 31, and 35-39 (in part), 43-45, and 49-53 (in part) drawn to a mixture of recombinant cells expressing a cell surface receptor, a receptor tyrosine kinase receptor, classified in class 435, subclasses 325, 252.3, 254.11, and 254.2.
- IX. Claims 1, 2, 4, 5, 7-17 (all in part), 22, 23-27 (in part), 32, 35-39 (in part), 48, and 49-53 (in part), drawn to a mixture of recombinant cells expressing a cell surface receptor, an orphan receptor, classified in class 435, subclasses 325, 252.3, 254.11, and 254.2.
- X. Claims 1, 2, 4, 5, 7-17, 23-27 (all in part), 33, 35-39 (in part), 46, and 49-53 (in part), drawn to a mixture of recombinant cells expressing a cell surface receptor, a cytokine receptor, classified in class 435, subclasses 325, 252.3, 254.11, and 254.2.
- XI. Claims 1, 2, 4, 5, 7-17, 23-27 (all in part), 34, 35-39 (in part), 47, and 49-53 (in part), drawn to a mixture of recombinant cells expressing a cell surface receptor, an MIRR receptor protein, classified in class 435, subclasses 325, 252.3, 254.11, and 254.2.
2. The inventions are distinct, each from the other for the following reasons. Inventions I-XI are distinct, each from the other, because each receptor represents a structural and functionally distinct molecule and thus cells expressing distinct receptors are

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distinct entities that are capable of supporting separate patents. The search and consideration of more than a group of invention constitutes an undue search burden on the office.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and the search required for a single group is not required for any other group, restriction for examination purposes as indicated is proper.
5. This application contains claims directed to patentably distinct species as set forth below. These species require non-cohesive searches and considerations.
 - (i) Claims 10, 12-16, and 27 contain nine species of detectable signals: color, fluorescence, luminescence, cell viability relief of a cell nutritional requirement, cell growth, drug resistance, intracellular calcium mobilization, intracellular protein phosphorylation, and an increase in phospholipid metabolism.
 - (ii) Claim 11 contains three species: chloramphenicol acetyl transferase, beta-galactosidase, and secreted alkaline phosphatase.
 - (iii) Claim 23, 24, 35-38, and 49-52 contain two species: yeast cells and mammalian cells.
 - (iv) Claim 42 contains numerous species of G-protein coupled receptors, as listed in the claim.

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(v) Claim 45 contains numerous species of the receptor tyrosine kinase, as listed in the claim.

Should applicants elect a group containing these claims, applicants are required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02 (a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable

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over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103 (a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48 (b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48 (b) and by the fee required under 37 CFR 1.17 (I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruixiang Li whose telephone number is (703) 306-0282. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564. The fax phone number for this Group is (703) 305-3014 or (703) 308-4242.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [yvonne.eyler@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record

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includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Ruixiang Li
Examiner
September 19, 2002



ELIZABETH KEIM
PRIMARY EXAMINER